PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number	:	09/688,694	Confirmation No.:	2049
Applicant	:	Christopher R. Lefebvre *et al*		
Filed	:	October 17, 2000		
Title	:	METHOD AND SYSTEM FOR RETAINING CUSTOMER LOYALTY		
TC/Art Unit	:	3622		
Examiner:	:	Boveja, Namrata		
Docket No.	:	47004.000062		
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below. This application was filed October 17, 2000. The claims were rejected under 35 U.S.C. § 103 by U.S. Patent No. 6,009,415 to Shurling in Office Actions mailed June 4, 2003 and December 1, 2003. The Shurling rejections were withdrawn and a Final Office Action mailed April 30, 2004 rejected the claims over a new reference, U.S. Patent No. 6,611,811 to Deaton. An Appeal Brief was filed July 30, 2004 in response to the 103 rejections over Deaton. The Deaton rejections were withdrawn and a new office action was mailed September 1, 2004 rejecting all the claims over another 103 rejection, this time the Examiner applied U.S. Patent No. 6,061,660 to Eggleston. That rejection was withdrawn in favor of yet another rejection mailed December 10, 2004 applying U.S. Patent No. 5,644,723 to Deaton. In response to minor amendments to the

claims, a final rejection was mailed July 14, 2005 applying the current combination of U.S. Patent No. 6,055,513 to Katz and U.S. Patent No. 6,616,128 to Smyk. Applicants filed a RCE with claim amendments on January 12, 2006 to expedite prosecution. The claims were rejected over a new reference, U.S. Patent No. 5,822,410 to McCausland ("McCausland") in an Office Action mailed April 17, 2006. Applicants amended the claims in the Response filed June 27, 2006. A Final Rejection was mailed on September 8, 2006 rejecting all the claims over a combination of McCausland and "Forging a Link Between Retention and Profits" by Steve Gasner ("Gasner").

Each of the rejections failed to properly address each and every claim limitation, and failed to articulate a proper statement of motivation. In sum, a *prima facie* case of obviousness has yet to be set forth for any of the office actions in this application, including the present Office Action dated September 8, 2006. Accordingly, rather than proceeding with another expensive appeal, Applicants respectfully request that the Office, following consideration of the remarks below, issue a Panel Decision allowing the application based on existing claims and closing the prosecution record. If the Panel declines to issue such a finding, then Applicants request that the Office either issue a proper office action stating a thoughtful basis for rejection or allow this application to proceed to appeal.

On the merits, claims 19, 22-29, and 32-38 have been rejected under 35 U.S.C. §103(a) as being unpatentable over McCausland in view of the Gasner article. This rejection is flawed for at least the following reasons. The Office Action fails to address each and every claim limitation. For the limitation directed to "*identifying the request as a request type* ***from a list of predetermined request types***, at a type module, where the request type identifies the customer's current situation," the Office Action relies on column 8, lines 49-lines 54 and Table 2. *See* pages 3 and 9, Office Action mailed September 8, 2006. The Office Action's reliance of McCausland

fails to properly identify at least this claim limitation. Column 4, lines 17-22 of McCausland purports to disclose call detail records which refer to whether or not calls have been dropped, call durations, feature usage, called parties, *etc.* This disclosure is not related to identifying the request as a request type. Column 8, lines 49-54 of McCausland purports to disclose defining potential customer problem factors and parameters where the parameters are stored in a database 42. According to McCausland, data item categories from database 42 are likely to indicate a problem the customer may be having. This information is used to predict a *potential* customer problem. Table 2 is described by McCausland as illustrating *potential* customer problem factors which a cellular telecommunications provide may find applicable. *See* column 8, lines 62-64. In addition, Figure 11 fails to illustrate any ability to identify the request as a request type ***from a list of predetermined request types***. In fact, there is no possible data field for this feature. Therefore, McCausland fails to properly address the ability to identify the request as a request type. For at least these reasons, the rejection should be withdrawn.

In addition, McCausland fails to disclose at least the step of "identifying one or more incentives, at an incentive module, *based on the request type, the customer segment and one or more profitability factors associated with the provider of the one or more incentives.*" The incentives of McCausland are not based on a combination of the request type, the customer segment and one or more profitability factors. In fact, there is no disclosure in McCausland that supports the Office Action's conclusions. Rather, McCausland clearly states that task 194 derives "an offer value using the customer worth for this customer/unit." *See* column 13, lines 57-58. There is no mention of basing an incentive on the <u>combination</u> of the request type, the customer segment and one or more profitability factors. The Office Action has not properly addressed at least this claim limitation.

The disclosure of McCausland is directed to determining churn likelihood. In other words, McCausland is directed to a predictive tool that performs calculations to determine the likelihood of future events that may or may not actual occur. In contrast, the claimed invention identifies a request type, identifies a customer segment and identifies incentives *in response to a request from a customer.* Therefore, McCausland fails to disclose "wherein the steps of identifying the request as a request type, identifying the customer as a customer segment and identifying one or more incentives are performed in response to the step of receiving a request from a customer."

As recognized by the Office Action, McCausland admittedly fails to disclose at least "***wherein the one or more incentives comprises at least one product or service offered by a financial institution***." *See* page 4, Office Action mailed September 8, 2006. For this deficiency, the Office Action relies upon the disclosure of Gasner. The Office Action alleges that Gasner teaches a customer retention method where one or more incentives comprise a product offered by a financial institution. Gasner appears to be generally discuss retaining existing customers for bank card issuers. *See* Abstract, Garner. The Office Action has failed to provide proper motivation for combining McCausland and Gasner. Rather, the Office Action alleges that it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to modify McCausland "to include providing products offered by a financial institution as retention incentives *if* McCausland's method was implemented to solve the retention problem for a financial services company *instead* of a cellular company. *See* page 4, Office Action mailed September 8, 2006 (emphasis added). Therefore, the alleged "motivation" relied upon by the Office Action is based on "*if* McCausland's method was implemented to solve the retention problem for a financial services company *instead* of a cellular company." However, the Office Action has failed to explain why one of ordinary skill in the art would have been motivated to

make the proposed substitution, absent improper hindsight.

Further, the system of Gasner is completely unrelated to the system of McCausland, which purports to establish rules for predicating the likelihood of churn in the cellular telecommunication industry, where churn is defined as the deactivation of an active customer account. *See* McCausland Abstract, col. 1, lines 9-11, col. 3, lines 39-49. In contrast, Gasner generally discusses retention efforts and statistical modeling for bank card issuers. *See* page 3 of Gasner. There is no teaching is Gasner that indicates how retention efforts of Gasner could even be applied to the method and system of McCausland that establishes rules for predicating the likelihood of churn in the cellular telecommunication industry.

The rejections of the independent claims over McCausland and Gasner are classic examples of hindsight reconstruction that is contrary to the law. The Office Action has failed to set forth a *prima facie* case of obviousness for the claims. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventors have done. The Examiner has clearly failed to reach the initial burden. Therefore, the pending claims are patentable over the prior art and are believed to be in condition for allowance. Thus, an appeal on the current rejections will certainly succeed, but the time and expense in preparing an appeal brief on these issue should not be borne by Applicants when the grounds are so clearly improper. Additionally, Applicants deserve to finally receive a notice of allowance or a proper, fully-articulated rejection on the best art the Examiner can locate, so that Applicants can work with the PTO to bring this meritorious application to allowance without further delay.

Respectfully submitted,

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